

1 [counsel listed on signature page]

2

3

4

5

6

7

8

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

11 ORACLE AMERICA, INC.

CASE NO. CV 10-03561 WHA (DMR)

12 Plaintiff,

**STIPULATION AND [PROPOSED]
ORDER REGARDING ORACLE
AMERICA, INC.'S FIRST
AFFIRMATIVE DEFENSE –
ASSIGNOR ESTOPPEL**

13 v.

14 GOOGLE INC.

Judge: Honorable William H. Alsup

15 Defendant.

16

17

18

19

20

21

22

23

24

25

26

27

28

STIPULATION

WHEREAS, Oracle in its Amended Complaint alleged that “Android (including without limitation the Dalvik VM and the Android software development kit) and devices that operate Android infringe one or more claims of each of United States Patents Nos. 6,125,447; 6,192,476; 5,966,702; 7,426,720; RE38,104; 6,910,205” (Dkt. No. 36);

WHEREAS, Google in its Answer to Oracle’s Amended Complaint and Amended Counterclaims alleged the invalidity of the seven patents-in-suit (Dkt. No. 51);

WHEREAS, Oracle in its Answer to Google’s Amended Counterclaims alleged that the doctrine of assignor estoppel barred Google’s assertion of invalidity based on Google’s employment of and being in privity with some of the inventors of the seven patents-in-suit (Dkt. No. 60);

WHEREAS, Google filed a précis letter seeking leave of the Court to file a motion for partial summary judgment on Oracle America, Inc.'s First Affirmative Defense of assignor estoppel (Dkt. No. 309);

WHEREAS, evidence obtained in discovery taken to date shows that Google employs or has employed James Gosling, named inventor of U.S. Reissue Patent No. RE38,104; Frank Yellin, a named inventor of U.S. Patent No. 6,061,520; and Lars Bak and Robert Greisemer, named inventors of U.S. Patent No. 6,910,205;

WHEREAS, based on evidence obtained in discovery taken to date, it appears that none of James Gosling, Frank Yellin, Lars Bak, and Robert Greisemer are an executive, officer, or substantial shareholder of Google and that none provided substantial “knowledge and assistance to develop any aspects of the accused Dalvik Virtual Machine or of the Android SDK that allegedly infringe the patents that those inventors assigned to Sun,” as Google wrote in its précis letter;

WHEREAS, Google argued in its précis letter that “[a]ssignor estoppel would be appropriate only if Google’s alleged infringement depended upon the engineers’ knowledge and assistance;”

WHEREAS, the Court granted Google leave to file a motion for partial summary

judgment on plaintiff's affirmative defense of assignor estoppel, but also noted that "Plaintiff's counsel remain free to negotiate a stipulated resolution of this issue." (Dkt. No. 325.)

NOW THEREFORE THE PARTIES HEREBY STIPULATE AND AGREE that:

1. Oracle's First Affirmative Defense (Assignor Estoppel) as against Google Inc. shall be dismissed with prejudice.

ORDER

The foregoing stipulation is approved, and IT IS SO ORDERED.

Date: _____

Honorable William H. Alsup
Judge of the United States District Court

1
2 Dated: September 2, 2011

MORRISON & FOERSTER LLP

3 By: /s/ Marc David Peters
4

5 MORRISON & FOERSTER LLP
6 MICHAEL A. JACOBS (Bar No. 111664)
mjacobs@mofo.com
7 MARC DAVID PETERS (Bar No. 211725)
mdpeters@mofo.com
8 DANIEL P. MUINO (Bar No. 209624)
dmuino@mofo.com
755 Page Mill Road
9 Palo Alto, CA 94304-1018
Telephone: (650) 813-5600
Facsimile: (650) 494-0792

10
11 BOIES, SCHILLER & FLEXNER LLP
12 DAVID BOIES (Admitted *Pro Hac Vice*)
dboies@bsfllp.com
13 333 Main Street
Armonk, NY 10504
14 Telephone: (914) 749-8200
Facsimile: (914) 749-8300
15 STEVEN C. HOLTZMAN (Bar No. 144177)
sholtzman@bsfllp.com
16 1999 Harrison St., Suite 900
Oakland, CA 94612
17 Telephone: (510) 874-1000
Facsimile: (510) 874-1460

18 ORACLE CORPORATION
19 DORIAN DALEY (Bar No. 129049)
dorian.daley@oracle.com
20 DEBORAH K. MILLER (Bar No. 95527)
deborah.miller@oracle.com
21 MATTHEW M. SARBORARIA (Bar No. 211600)
matthew.sarboraria@oracle.com
22 500 Oracle Parkway
Redwood City, CA 94065
23 Telephone: (650) 506-5200
Facsimile: (650) 506-7114

24 *Attorneys for Plaintiff*
ORACLE AMERICA, INC.
25
26
27
28

1
2 Dated: September 2, 2011

KEKER & VAN NEST LLP

3 By: /s/ Matthias Kamber
4

5 KEKER & VAN NEST LLP
6 ROBERT A. VAN NEST (SBN 84065)
7 rvannest@kvn.com
8 CHRISTA M. ANDERSON (SBN184325)
9 canderson@kvn.com
710 Sansome Street
San Francisco, CA 94111-1704
Telephone: (415) 391-5400
Facsimile: (415) 397-7188

10 KING & SPALDING LLP
11 SCOTT T. WEINGAERTNER (*Pro Hac Vice*)
12 sweingaertner@kslaw.com
13 ROBERT F. PERRY
14 rperry@kslaw.com
15 BRUCE W. BABER (*Pro Hac Vice*)
16 bbaber@kslaw.com
17 1185 Avenue of the Americas
18 New York, NY 10036-4003
19 Telephone: (212) 556-2100
20 Facsimile: (212) 556-2222

21 KING & SPALDING LLP
22 DONALD F. ZIMMER, JR. (SBN 112279)
23 fzimmer@kslaw.com
24 CHERYL A. SABNIS (SBN 224323)
25 csabnis@kslaw.com
101 Second Street - Suite 2300
San Francisco, CA 94105
Telephone: (415) 318-1200
Facsimile: (415) 318-1300

26 GREENBERG TRAURIG, LLP
27 IAN C. BALLON (SBN 141819)
28 ballon@gtlaw.com
HEATHER MEEKER (SBN 172148)
meekerh@gtlaw.com
1900 University Avenue
East Palo Alto, CA 94303
Telephone: (650) 328-8500
Facsimile: (650) 328-8508

Attorneys for Defendant
GOOGLE INC.

1

2 ATTESTATION

3

4

5

6

7

8

9

10

11

12

13

14

15

16

17

18

19

20

21

22

23

24

25

26

27

28

I, Matthias Kamber, am the ECF User whose ID and password are being used to file this STIPULATION AND [PROPOSED] ORDER REGARDING ORACLE AMERICA, INC.'S FIRST AFFIRMATIVE DEFENSE – ASSIGNOR ESTOPPEL. In compliance with General Order 45, X.B., I hereby attest that Marc David Peters and Matthias Kamber have concurred in this filing.

Date: September 2, 2011

/s/ Matthias Kamber
